

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 07844-0497001
	Application Number 10/072,260	Filed February 6, 2002
	First Named Inventor James D. Pravetz	
	Art Unit 2134	Examiner Christopher J. Brown
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"> <div style="width: 45%;"> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>52,978</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> </div> <div style="width: 45%; text-align: center;"> <p>_____ /Brian J. Gustafson/ Signature</p> <p>_____ Brian J. Gustafson Typed or printed name</p> <p>_____ (650) 839-5070 Telephone number</p> <p>_____ May 21, 2009 Date</p> </div> </div> <p style="font-size: small; margin-top: 20px;">NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below'.</p>		
<input checked="" type="checkbox"/> Total of 1 forms are submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: James D. Pravetz	Art Unit	: 2134
Serial No.	: 10/072,260	Examiner	: Christopher J. Brown
Filed	: February 6, 2002	Conf. No.	: 3277
Title	: AUTOMATED PUBLIC KEY CERTIFICATE TRANSFER		

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The brief is in response to legal and factual deficiencies in the final Office Action mailed January 23, 2009, and the Advisory Action mailed April 8, 2009.

Claims 1-9, 11-14, 16-20, 23-24, 26-31, and 33-51 were pending as of the action mailed on January 23, 2009. Claims 1-7, 9-10, 12-14, 16-17, 19, 23-24, 26-28, 30-31, 33-36, 38-39, 41-46, 48, and 50 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent Application Publication No. 2002/0010746 ("Jilk") in view of Dusse et. al., *S/MIME Version 2 Message Specification*, THE INTERNET ENGINEERING TASK FORCE REQUEST FOR COMMENTS: 2311, March 1998, ("Dusse") in view of U.S. Patent No. 6,078,951 ("Pashupathy"). Claims 8, 11, 18, 20, 29, 37, 40, 47, 49, and 51 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Jilk, Dusse and Pashupathy as applied to claim 1, and further in view of ADOBE SYS. INC., PDF REFERENCE (2d ed. 2000) ("PDF Reference").

The relied upon portions of the cited art do not disclose or suggest a first application's instruction to use a second application to transmit first container object or automatically obtaining a second container object from the second application

Claim 1 recites a first application's instructions to perform operations on a client including using a second application on the client distinct from the first application to transmit the first container object to a recipient's address, wherein the second application is an e-mail client application or a Web browser application.

With respect to the first and second applications, the examiner states:

Regarding Claim 1 : First application on a client to generate a first container object with a recognizable container type which is associated with the first application (Jilk paragraphs 17-18, 21, 23, 97; 2312 section 2.2,2.3) The process

of utilizing S/MIME dictates that certificates are exchanged prior to communication in order to provide for the secured communications. This process clearly creating a container with a plugin (1st application), which contains the sender's certificate and a request for a recipient's certificate. The 2nd application in this case considered to be an email program (Office Action, page 4).

The examiner further states that Jilk discloses the claimed second application as an e-mail application at FIGS. 3A and 3B; paragraph 0096, lines 9-30; and paragraph 0097.

The examiner attempts to clarify the first application on page 2 of the office action stating:

As per the examiners rejection below, the first application is an encryption application along the lines of the S/MIME authentication scheme (Dusse). The second application is the email web application that transmits the container object formed by the S/MIME application to a recipients address (Pashupathy).

The applicant respectfully disagrees. None of the cited portions of the references relied upon by the examiner disclose or suggest an "encryption application" identified by the examiner. In claim 1, the first application uses a second application on the client distinct from the first application to transmit the first container object to a recipient's address. However, nothing in the cited portions disclose or suggest such a first application that can instruct a second application. In particular, the examiner cites a number of paragraphs in Jilk and parts of the Dusse standard.

Additionally, on page two of the Office Action, the examiner simply relies on some application "along the lines of S/MIME authentication scheme". Dusse, however, does not identify applications. Moreover, the examiner does not identify any specific disclosure or suggestion in Dusse of such an application. Instead Dusse simply provides the S/MIME technical specification that describes a secure MIME data format. No applications for performing authentication using the S/MIME format are disclosed. Dusse does not disclose or suggest any application for generating containers. Moreover, Dusse does not disclose or suggest that the application includes instruction to use a second distinct application to send the container, as required by claim 1.

Regardless of whether or not the S/MIME specification contemplates a plugin to create a container (as the examiner contends), this does not disclose or suggest an application that has instructions to use another application. The examiner provides no evidence in support of this

contention and therefore appears to be making a factual assertion. Such a factual assertion, when challenged, requires the examiner to provide evidentiary support as required by MPEP 2144.03. In particular, there is nothing in the cited portions of the S/MIME specification that discloses or suggests that there is some application that creates a container. Nor is there any disclosure or suggestion in the cited portion that the application then uses another application to send the container (i.e., that a S/MIME plugin includes instruction to use an e-mail application to send a container). The applicant respectfully submits that the examiner must provide evidentiary support for these assertions as required by MPEP 2144.03.

Furthermore, the examiner states that "Pashupathy teaches a plugin application to allow an application regarding MIME containers to be used in conjunction with a web browser email program" (Office Action, page 4). In particular, the examiner cites col. 1, lines 24-32 and col. 4, lines 30-60. The applicant respectfully disagrees. Pashupathy discloses a number of different viewer plugins for viewing different types of data including MIME data. *See* col. 4, lines 28-64. MIME is simply a standard for presenting data. A plugin for viewing MIME data simply presents the MIME content to a user and does not generate a container object. Thus, the cited portions of Pashupathy simply disclose that there are plugins to view different types of data.

The applicant respectfully submits that there is no disclosure or suggestion in Pashupathy that the plugin generates any container object. Furthermore, there is no disclosure or suggestion in Pashupathy that the viewer plugin is a distinct application that includes instructions to use a second application to send the container. More particularly, this would not make sense in the context of a viewer. Thus, Pashupathy does not disclose or suggest the claimed first application.

The cited portions of Jilk (paragraphs 17-18, 21, 23, 97) also fail to disclose or suggest the claimed first application. Paragraphs 17-18 and 21 simply disclose that an e-mail application can interact with HTML content provided by a server. Thus, this is interaction between an e-mail application of a client (identified by the examiner as the second application) and a remote server. Paragraph 23 states that e-mail can use a MIME format to display data. Finally, paragraph 97 states that user can transmit a URL request or form data using the e-mail application. There is no disclosure or suggestion in any of these paragraphs of any application other than the e-mail application. There is also no disclosure or suggestion of S/MIME or any application using S/MIME. Furthermore, there is no disclosure or suggestion of any application

that includes instructions to use a second distinct application to send the container object generated by the first application.

Thus, it is unclear how the cited paragraphs relate at all to the claim feature. The applicant further notes that the examiner simply cites to a number of paragraphs of Jilk without explaining how those paragraphs teach the claimed first application. In particular, the examiner does not identify either the first application or any disclosure identifying how the first application has instructions to use the second application to send the container, as required by claim 1.

The applicant respectfully submits that the examiner is considering each claim feature in isolation without considering the claim as a whole. Consequently, the examiner fails to consider the interaction between the first application and second application required by claim 1. As such, the cited references alone or in combination fail to disclose or suggest a first application that generates a container and includes instructions to use a second distinct application to send the container.

Claim 1 also recites automatically obtaining a second container object from the second application, the second container object having been received by the second application and the second container object having the same recognizable container type as the first container object. The examiner states that Jilk discloses the claimed automatic obtaining of a second container object from the second application at paragraph 0097. The applicant respectfully disagrees.

Paragraph 0097 of Jilk discloses a user transmitting a URL request or form data using an e-mail application. However, Jilk does not disclose or suggest automatically obtaining a second container object from the second application, as required by claim 1. In particular, claim 1 recites that it is the first application that automatically obtains the second container. However, the examiner's analysis simply states that "the email application clearly receives any response from WinSock wherein the container object type is of a standard email format" (Office Action, page 5). This does not reference the first application at all. It is the first application that obtains the second container from the second application. The examiner only identifies the second application (e-mail) as receiving the container. Thus, the examiner has entirely failed to address this feature of claim 1, which is clear legal error.

Claim 1 specifically requires that the first application include instructions to use the second application. Claim 1 also specifically recites that the first application automatically

obtain a second container received by the second application. However, the examiner does not identify these features as present in Jilk, Dusse, or Pashupathy. Instead the examiner simply argues that the first application exists without identifying where the references specifically disclose the first application and without identifying where the cited references disclose that the first application includes instructions to use the second application. The examiner also argues that the second application obtains the second container rather than the first application, as required by claim 1. Consequently, by failing to address each claim feature the examiner also fails to make a *prima facie* case for obviousness under Section 103. "If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992) (emphasis added). Therefore, the applicant respectfully submits that claim 1, as well as claims 2-8, which depend from claim 1, are in condition for allowance.

Claims 9 and 13 recite features corresponding to claim 1 and were rejected for the same reasons. Therefore, for the reasons set forth above with respect to claim 1, claims 9 and 13, as well as their dependent claims are also in condition for allowance.

Claims 30, 38, 42, and 50 recite a first application that generates a first container object and a second distinct application that transmits the first container object to a recipient. As set forth above with respect to claim 1, the examiner has failed to identify a first application that generates a first container object. Therefore, for the same reasons as set forth above with respect to claim 1, claims 30, 38, 42, and 50, as well as their respective dependent claims are also in condition for allowance.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: May 21, 2009

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